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10/001,612	10/25/2001	Clive P. Hohberger	7887/83890	1448

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EXAMINER	
HARAN, JOHN T	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/001,612	HOHBERGER ET AL.	
	Examiner	Art Unit	
	John T. Haran	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-20 and 35-125* is/are pending in the application.

4a) Of the above claim(s) *14-20 and 35-106* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *107-125* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *see action*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group IV, claims 107-125 in the response filed on 11/3/03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 1/25/01, 12/30/02, 5/19/03 and 6/26/03 have been considered by the examiner. The three documents cited on the IDS submitted on 1/25/01 have been struck through because they are also listed on the IDS submitted on 12/30/02.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 108 and 111 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 108, there does not appear to be any support in the specification that applicant had possession, at the time the application was filed, for applying a RFID integrated circuit to the adhesive back surface of a media so that it contacts an antenna structure on the adhesive back surface of the media to form a RFID transponder. It is noted that as described in the specification an RFID transponder includes both an antenna structure and a RFID integrated circuit. The specification provides support for an embodiment (Figures 3-10 and 20-24) wherein labels with an adhesive back surface laminated to a carrier are delaminated from the carrier to expose the adhesive back surface so that a value-adding element, such as an RFID transponder, can be applied to the adhesive back surface. A separate embodiment (Figures 11-16) provides support for applying a value-adding element to the front surface of a stiff media that does not contain an adhesive layer, such as tickets, tags, and plastic cards (paragraph 0068), wherein the media sample has a conductive antenna pattern printed on the front surface and an RFID integrated circuit is applied to the front surface to contact the antenna pattern and form an RFID transponder (paragraph 0083). There is no indication that the two embodiments are combinable or how a combination of the two, such as applying a RFID integrated circuit to the adhesive back surface of a media, which has been delaminated from a carrier, so that it contacts an antenna structure on the adhesive back surface of the media to form a RFID transponder, would work or be performed. It is noted that claim 108 is an original claim and its contents can be incorporated into the specification, however doing such would not rectify the issue because there would still be no indication how the

combination would work or be performed (See MPEP 2163-IA). One skilled in the art, reading the specification as a whole as filed at the time of application, would not have reasonably understood that applicant had possession of applying a RFID integrated circuit to the adhesive back surface of a media, which has been delaminated from a carrier, so that it contacts an antenna structure on the adhesive back surface of the media to form a RFID transponder at the time the application was filed.

Regarding claim 111, there does not appear to be any support in the specification that applicant had possession, at the time the application was filed, for applying an RFID transponder to the adhesive back surface of a label that has been delaminated from a carrier, wherein the RFID transponder is programmed with process control instructions for controlling a process of applying a second value-adding element to the media to which the RFID is applied. The specification provides support for an embodiment (Figures 3-10 and 20-24) wherein labels with an adhesive back surface laminated to a carrier are delaminated from the carrier to expose the adhesive back surface so that a value-adding element, such as an RFID transponder, can be applied to the adhesive back surface. A separate embodiment provides support for supplying a stock roll of postcards wherein an RFID transponder and other value-adding elements are adhered to a front surface of the postcard and the RFID transponder is programmed with instructions that control what other value-adding elements are adhered to the front surface of the postcard (See Figure 19 and paragraph 0124). There is no indication that the two embodiments are combinable or how the programmed instructions of controlling application of a second value-adding element to the label in the combination of the two,

such as applying an RFID transponder to the adhesive back surface of a label that has been delaminated from a carrier, wherein the RFID transponder is programmed with process control instructions, such as controlling a process of applying a second value-adding element to the label to which the RFID is applied, would work or be performed. It is noted that claim 111 is an original claim and its contents can be incorporated into the specification, however doing such would not rectify the issue because there would still be no indication how the combination would work or be performed (See MPEP 2163-IA). One skilled in the art, reading the specification as a whole as filed at the time of application, would not have reasonably understood that applicant had possession of applying an RFID transponder to the adhesive back surface of a label that has been delaminated from a carrier, wherein the RFID transponder is programmed with process control instructions for controlling a process of applying a second value-adding element to the label to which the RFID transponder is applied at the time the application was filed.

5. Claims 108 and 111 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 108, as noted above, the specification enables applying a RFID transponder (antenna and RFID integrated circuit) to the adhesive back surface of a

label that has been exposed by delaminating it from a carrier (Figures 3-10 and 20-24). The specification also enables printing an antenna pattern on a non-adhesive front surface of a tag, plastic card, or ticket, and applying an RFID integrated circuit to the front surface of the media so that the RFID integrated circuit contacts the antenna pattern and forms a RFID transponder (Figures 11-16, paragraphs 0068 and 0083). However the specification does not enable applying a RFID integrated circuit to the adhesive back surface of a media, which has been delaminated from a carrier, so that it contacts an antenna structure on the adhesive back surface of the media to form a RFID transponder. There is no indication how such a process would be performed. When would the antenna pattern be formed on the back surface of the label? Before being laminated to the carrier or after being delaminated? When and where would the adhesive be applied to the back surface of the label? Before or after the formation of the antenna pattern? One of ordinary skill in the art reading the specification as a whole would not be enabled to apply a RFID integrated circuit to the adhesive back surface of a media, which has been delaminated from a carrier, so that it contacts an antenna structure on the adhesive back surface of the media to form a RFID transponder because they would not be able to ascertain from the specification how to do such.

Regarding claim 111, as noted above, the specification enables applying a RFID transponder (antenna and RFID integrated circuit) to the adhesive back surface of a label that has been exposed by delaminating it from a carrier (Figures 3-10 and 20-24). The specification also enables supplying a stock roll of postcards wherein an RFID transponder and other value-adding elements are adhered to a front surface of the

postcard and the RFID transponder is programmed with instructions that control what other value-adding elements are adhered to the front surface of the postcard (See Figure 19 and paragraph 0124). However, the specification does not enable applying an RFID transponder to the adhesive back surface of a label that has been delaminated from a carrier, wherein the RFID transponder is programmed with process control instructions for controlling a process of applying a second value-adding element to the label to which the RFID transponder is applied. There is no indication how such programmed instructions for controlling the application of a second value-adding element to the label to which the RFID transponder is applied would be performed. When would the second value-adding element be applied? Where would it be applied? How would it be applied? The application of a second value-adding element to the same label as the programmed RFID transponder applied to the adhesive back surface of a label delaminated from a carrier is not enabled and consequently programming instructions on how to control the application of such a second value-adding element is not enabled. One of ordinary skill in the art reading the specification as a whole would not be enabled to apply an RFID transponder to the adhesive back surface of a label that has been delaminated from a carrier, wherein the RFID transponder is programmed with process control instructions for controlling a process of applying a second value-adding element to the label to which the RFID transponder is applied because they would not be able to ascertain from the specification how to do such.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 107-125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 107 is indefinite because it is unclear what is meant by the term media samples. It appears applicant intends for it to include labels, tickets, tags, or cards or other media. It is suggested to amend the preamble and first step of claim 107 to read -- A method of manufacturing a plurality of adhesive-backed media, comprising the steps of: moving a series of adhesive-backed media samples laminated on a carrier- -.

Claim 108 is indefinite because the relation between the antenna pattern and the adhesive back surface is not clear. Is the antenna pattern formed over the adhesive or is the adhesive formed over the antenna pattern or is there no adhesive in the area of the antenna?

Claim 111 is indefinite because it is unclear where, when or how the second value-adding element is applied to the media. Is it applied to the adhesive back surface or the front surface? Is it applied while the media is delaminated from the carrier? How is it applied?

Claim 125 recites the limitation "said position". There is insufficient antecedent basis for this limitation in the claim. It appears claim 125 should depend from claim 124 instead of claim 107.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 107 and 122 are rejected under 35 U.S.C. 102(e) as being anticipated by Duschek (U.S. Patent 6,334,921).

Duschek is directed to a method for manufacturing labels (media) for electronic article surveillance wherein adhesive backed labels (media samples) are placed on a carrier web and subsequently the carrier web carries the labels and the labels are delaminated from the carrier thereby exposing the adhesive back surface of the labels, allowing for security elements (value-adding elements) to be adhered to the adhesive back surface of the labels (Column 3, lines 33-65). Duschek teaches applying the security elements only to selected labels, such as every fourth label (Column 2, lines 11-16). Duschek anticipates claim 107.

Regarding claim 122, Duschek discloses that there is a control device that controls the speed of the security element application and thus how many labels are skipped between security element applications (Column 2, lines 11-16 and 57-62). The control process is controlled by a computer program (Column 4, lines 41-59). Duschek anticipates claim 122.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 109, 110, and 112-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek (U.S. Patent 6,334,921) in view of Fox et al (U.S. Patent 6,280,544).

Duschek is relied upon for the teachings noted above.

Regarding claim 109, Duschek is silent towards adhering an RFID transponder to the adhesive back surface of the labels once they are delaminated from the carrier, however such is well known and conventional in the label art, as shown for example in Fox et al (See abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply known value-adding elements, such as an RFID transponder, to the adhesive back surface of the labels in the method of Duschek, as is conventional in the art as evidenced by Fox et al.

Regarding claim 110, it is well known and conventional for RFID transponders to be programmed with process control instructions, as shown for example in Fox et al, which teaches having the RF tag (RFID transponder) programmed with process control instructions such as special handling requirements of the labeled item (Column 5, lines 5-19). It would have been obvious to program the RFID transponder with process control instructions in the method of Duschek, as modified above.

Regarding claims 112-113, it is well known and conventional in the art to communicate with the RFID transponder prior to applying it to the media for a variety of purposes including testing, identifying, reading information, writing information, or discerning a characteristic of the transponder, as shown for example in Fox et al, which teaches writing information to the transponder prior to application to a label (Column 4, lines 24-26). It would have been obvious to do so in the method of Duschek, as modified above.

Regarding claims 114-115, it is well known and conventional to print information on labels prior to application of a value-adding element such as a transponder, as shown for example in Fox et al (See abstract). It would have been obvious to perform well known and conventional processing steps on the label in the process of Duschek.

Regarding claims 116 and 117, it is well known and conventional in the art when applying value-adding elements, such as RF tags, to the adhesive back surface of a label for the RF tags to have a non-adhesive front surface that is bonded to the adhesive back surface of the label and to have an adhesive back surface and to apply pressure such as through pinch rollers to improve adherence, as shown for example in Fox et al (Column 4, lines 12-20; Column 7, lines 53-56). It would have been obvious to perform well known and conventional procedures customary in the art in the method of Duschek.

12. Claim 118 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek (U.S. Patent 6,334,921) in view of Fox et al (U.S. Patent 6,280,544) as applied to claim 116 above, and further in view of Kathmann et al (U.S. Patent 6,123,796).

Duschek and Fox et al are relied for the teachings noted above and both are silent towards using a tamping device to press the label and RF tag together.

One skilled in the art would have readily appreciated that there are numerous conventional means for pressing a transponder (EAS target) against a label, including rollers, air jets, and tamping devices, as shown for example in Kathmann et al (Column 4, lines 45-49). One skilled in the art would have readily appreciated that pressing via the rollers taught in Fox et al or pressing via a tamping device as suggested in Kathmann et al are alternate expedients obvious over one another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to press the RF tag and label together by tamping in the method of Duschek, as modified above, as suggested in Kathmann et al.

13. Claims 119-121 and 123-125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duschek (U.S. Patent 6,334,921) in view of Kathmann et al (U.S. Patent 6,123,796).

Duschek is relied upon for its teachings noted above.

Regarding claim 119, Duschek teaches that the security elements are applied to the delaminated carrier and then the security elements and carrier are laminated to the label. Duschek is silent towards applying the security element to the label and then

afterwards laminating the label to the carrier, however such is well known and conventional in the art, as shown for example in Kathmann et al (See abstract). One skilled in the art would have readily appreciated that the two are alternative expedients that result in the same product and are obvious one over the other. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the label on a carrier after applying the security element in the method of Duschek, as suggested in Kathmann et al.

Regarding claim 120, Kathmann et al teaches the carrier applied to the label with the target can be the same carrier previously removed or a different carrier (See abstract).

Regarding claim 121, Kathmann et al teaches laminating by pressing rollers (Column 4, lines 45-50) and one skilled in the art would have appreciated pressing the carrier-element-media laminate using such conventional means to ensure adequate adhesion. It would have been obvious to do so in the method of Duschek, as modified above.

Regarding claims 123-125, Kathmann et al teaches there are numerous conventional means for pressing an EAS target against a label, including rollers, air jets, and tamping devices. One skilled in the art would have readily appreciated that when using a tamping device to apply the EAS target, the carrier would be paused during the applying step, in order to allow adequate pressure to be applied for an appropriate length of time and in order to prevent buckling of the carrier. Additionally one skilled in the art would have readily appreciated that the EAS target would be fed to the tamping

device in a direction transverse to the movement of the carrier and that the tamping device would be retracted after the EAS target is applied to the label (See Figure 4B). It would have been obvious to use a tamping device for the pressing means and for the carrier to pause during application of the EAS target or for the EAS targets to be fed in a direction transverse to the direction of the carrier and to retract the tamping device after application in the method of Duschek as suggested in Kathmann et al.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(703) 305-0052 or (571) 272-1217 as of 12/19/03**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

John T. Haran
Examiner
Art Unit 1733